



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,253	11/24/1999	ALAN EDWARD BELL	AM9-99-0122	4831

7590 01/15/2003

JOHN L ROGITZ
ROGITZ & ASSOICATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101

EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/448,253

Applicant(s)

LOTSPIECH ET AL.

Examiner

Cristina O Sherr

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 9-12 have been canceled. Claims 1-8 and 13-24 remain pending in this action.

Response to Arguments

2. Applicant's arguments with respect to claims 1-8 and 13-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 5,513,260A) in view of Pham et al (US 5,513,260A) further in view of Lane et al (US 5,258,983A).
5. Ryan discloses a computer-based system for inhibiting unauthorized recording of digitized music, comprising a cryptography module including logic executable by a provider computer, the logic including, for at least a segment of the music, obtaining an authorized digital signature, and then associating the authorized digital signature with the music; and a consumer module associated with a consumer music player and executable thereby to undertake logic including processing at least the segment of the

Art Unit: 3621

music to obtain a test digital signature, and, only if the test digital signature matches the authorized digital signature, permitting recording the music, on the consumer music player (Col 2 ln 15 – col 4 ln 22);

wherein the cryptography module derives authorized digital signatures for respective plural segments of the music, and associates the authorized digital signatures with the music (Col 2 ln 15 – col 4 ln 22);

wherein the consumer module determines test digital signatures for respective plural segments of the music, the consumer module preventing at least one of: compression of the music, and recording of the music, unless a predetermined relationship exists between test digital signatures and the authorized digital signatures (Col 2 ln 15 – col 4 ln 22).

6. Ryan does not, however, disclose the system of Claim 1, above, wherein the music is stored in a data stream on a disk, and the authorized digital signature is associated with the music by storing the authorized digital signature on the disk, apart from the stream (Pham Col 3 ln 20 – 52);

wherein the music is stored in a data stream on a disk, and the authorized digital signature is associated with the music by storing the authorized digital signature on the disk as part of the stream (Pham Col 3 ln 20 – 52);

wherein the authorized digital signature is tagged with a signature date, and the consumer module processes the music using a 3 current key or an expired key having a key date equal to or later than the signature date (Pham Col 3 ln 20 – 52). Pham, however, does, as noted above.

7. Further neither Ryan nor Pham disclose the preventing compression of data such as music in the absence of an authorized signature (Lane, Col 2 ln 8 – col 6 ln 36).

Lane, however, does, as noted above.

8. It would be obvious to one of ordinary skill in the art to combine the teaching of Ryan, Lane and Pham in order to obtain greater security in the distribution of music while preserving data integrity.

9. Claims 7 - 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 5,513,260A) in view of Pham et al (US 5,513,260A) and further in view of Lane et al (US 5,258,983A).

10. Ryan discloses a computer program storage device including a program of instructions for determining whether a request to record digitized music should be honored, the program of instructions including computer readable code means for processing at least one segment of the music to obtain a test digital signature; computer readable code means for receiving an authorized digital signature associated with the music; and computer readable code means for permitting recording of the music only if at least the test digital signature matches the authorized digital signature (Col 2 ln 15 – col 4 ln 22).

11. Ryan does not, however, disclose the device of Claim 7, above, further comprising computer readable code means for determining test digital signatures for respective plural segments of the music; and computer readable code means for preventing recording of the music, unless a predetermined number or percentage of

matches exist between test digital signatures and authorized digital signatures date (Pham Col 3 In 20 – 52). Pham, however, does, as noted above.

12. Further neither Ryan nor Pham disclose the preventing compression of data such as music in the absence of an authorized signature (Lane, Col 2 In 8 – col 6 In 36).

Lane, however, does, as noted above.

13. It would be obvious to one of ordinary skill in the art to combine the teaching of Ryan, Lane and Pham in order to obtain greater security in the distribution of music while preserving data integrity.

14. Claims 13 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 5,513,260A) in view of Pham et al (US 5,513,260A) further in view of Lane et al (US 5,258,983A).

15. Ryan discloses a method for facilitating the storage, on a personal music player, of digitized music received on a disk in an authorized transaction, comprising the acts of recording the music on the disk along with at least one authorized digital signature derived from the music (Col 2 In 15 – col 4 In 22).

16. Ryan does not, however, disclose the method of claim 13, above, further comprising the acts of delivering plural authorized digital signatures from respective segments of the music and recording the plural authorized signatures on the disk (Pham Col 3 In 20 – 52);

17. Further comprising the acts of deriving plural test digital signatures from plural segments of the music and undertaking the recording act only if a predetermined

number of matches exist between test digital signatures and authorized digital signatures (Pham Col 3 In 20 – 52);

wherein the authorized digital signature is stored on the disk apart from the music (Pham Col 3 In 20 – 52);

wherein the authorized digital signature is stored on the disk in the music (Pham Col 3 In 20 – 52);

wherein the authorized digital signature is tagged with a signature date and the deriving act includes the processing the music using a current key or an expired key having a key date equal to or later than the signature date (Pham Col 3 In 20 – 52).
Pham, however, does, as noted above.

18. Further neither Ryan nor Pham disclose the preventing compression of data such as music in the absence of an authorized signature (Lane, Col 2 In 8 – col 6 In 36).
Lane, however, does, as noted above.

19. It would be obvious to one of ordinary skill in the art to combine the teaching of Ryan, Lane and Pham in order to obtain greater security in the distribution of music while preserving data integrity.

20. Claims 21 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 5,513,260A) in view of Pham et al (US 5,513,260A) further in view of Lane et al (US 5,258,983A).

21. Ryan discloses a computer program storage device including a program of instructions for determining whether a request to record digitized music should be honored, the program of instructions undertaking method acts comprising: processing at

least one segment of the music to obtain a test digital signature; receiving an authorized digital signature associated with the music; and permitting recording of the music only if at least the test digital signature matches the authorized digital signature (Col 2 ln 15 – col 4 ln 22).

22. Ryan does not, however, disclose the device of Claim 21, above, wherein the method acts further comprise determining test digital signatures for respective plural segments of the music; and preventing at least one of: compression of the music, and recording of the music, unless a predetermined number or percentage of matches exist between test digital signatures and authorized digital signatures (Pham Col 3 ln 20 – 52). Pham, however, does, as noted above.

23. Further neither Ryan nor Pham disclose the preventing compression of data such as music in the absence of an authorized signature (Lane, Col 2 ln 8 – col 6 ln 36). Lane, however, does, as noted above.

24. It would be obvious to one of ordinary skill in the art to combine the teaching of Ryan, Lane and Pham in order to obtain greater security in the distribution of music while preserving data integrity.

25. Claims 23 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 5,513,260A) in view of Pham et al (US 5,513,260A) further in view of Lane et al (US 5,258,983A).

26. Ryan discloses a method for facilitating the storage, on a personal music player, of digitized music received on a disk in an authorized transaction, comprising the acts of engaging the disk with a personal music player compression device; deriving at least

Art Unit: 3621

one test digital signature from the music; and recording the music on the personal music player only if the at least one test digital signature matches at least one digital signature received on the disk (Col 2 ln 15 – col 4 ln 22).

27. Ryan does not, however, disclose the method of Claim 23, above, further comprising the acts of deriving plural authorized test digital signatures from respective segments of the music; and comparing the test digital signatures with authorized digital signatures on the disk (Pham Col 3 ln 20 – 52). Pham, however, does, as noted above.

28. Further neither Ryan nor Pham disclose the preventing compression of data such as music in the absence of an authorized signature (Lane, Col 2 ln 8 – col 6 ln 36). Lane, however, does, as noted above.

29. It would be obvious to one of ordinary skill in the art to combine the teaching of Ryan, Lane and Pham in order to obtain greater security in the distribution of music while preserving data integrity.

30. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Art Unit: 3621

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. Cotugno et al (US 6,353,887B1) teaches a digital signaturing method and system for re-creating specialized native files out of a container imported from an open network or residing on a CD-Rom.

33. Mueller et al (US 6,188,659B1) teaches a method for insuring uniqueness of an original CD.

34. Copeland et al (US 5,659,613A) teaches a method and apparatus for copy protection for various recording media using a video fingerprint.

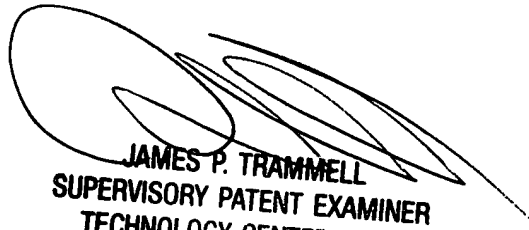
35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

37. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/448,253
Art Unit: 3621

Page 10



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600